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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,834	02/28/2007	Johann Manner	4838-001	6903
22429	7590	08/19/2009	EXAMINER	
LOWE HAUPTMAN HAM & BERNER, LLP			JUSKA, CHERYL ANN	
1700 DIAGONAL ROAD				
SUITE 300			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1794	
			MAIL DATE	DELIVERY MODE
			08/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/560,834	MANNER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Cheryl Juska	1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 May 2009.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6-8,10 and 11 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,6-8,10 and 11 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/06/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### *Response to Amendment*

1. Applicant's amendment filed May 6, 2009, has been entered. The specification and claims 1-4 and 6-8 have been amended as requested. Claims 5 and 9 have been cancelled and new claims 10 and 11 have been added. Thus, the pending claims are 1-4, 6-8, 10, and 11.
2. Said amendment is sufficient to overcome the objection to the specification as set forth in section 1 of the last Office Action (Non-Final Rejection mailed 02/18/2009). Additionally, said amendment is also sufficient to withdraw the 112, 2<sup>nd</sup> rejections as set forth in sections 4-6 of the last Office Action. Furthermore, said amendment overcomes the 112, 1<sup>st</sup> rejection set forth in section 9 of the last Office Action.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-4, 6-8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 provides for "a method of using a cellulosic fiber of the lyocell type in carpets, textile flooring materials, wall linings and/or decoration materials," but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a method of using without

any active, positive steps delimiting how this use is actually practiced. Note the recitation “a method of using a cellulosic fiber of the lyocell type in carpets, textile flooring materials, wall linings and/or decoration materials” is merely the preamble limitation of the claim and not positively recite any active method steps. Claims 2-4, 6-8, and 10 are rejected for their dependency upon claim 1.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), which states, “Presence or absence of such words as “process, art or method” or “which comprises” is not of critical importance under 35 U.S.C. 100(b); however, process or method claim should recite at least one process step.” Applicant's claim 1 fails to recite any actual process steps. Claims 2-4, 6-8, and 10 are rejected for their dependency upon claim 1.

***Claim Rejections - 35 USC § 102/103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-4 and 6-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,235,392 issued to Luo et al.

10. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,235,392 issued to Luo et al.

Luo discloses lyocell fibers and a method of making said fibers (title and abstract).

While the invention of the patent is directed to microdenier lyocell fibers (abstract and claims), the reference explicitly teaches fibers made by centrifugal spinning having diameters in the range of 3.1-19.5 denier (3.4-21.7 dtex) are easily formed (col. 11, lines 13-22). Additionally, Luo teaches the fiber lengths vary from 0.5-25 cm (i.e., staple fiber length) (col. 11, lines 22-24). Luo teaches the lyocell fibers are used to make yarns, woven fabrics, and/or nonwoven fabrics (abstract and col. 1, lines 9-12).

Thus, Luo teaches applicant's invention with the exception of (a) the use of the fibers in the recited applications and (b) the recited ratio V. Regarding the first exception, it is noted that the use of the fibers in said applications is merely a preamble limitation. As such, it is not given patentable weight at this time. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, note since the claim does not recite any active method steps of said use, the preamble limitation is merely descriptive of intended use. A recitation of the intended use of the

claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is asserted that the fibers of the Luo invention are clearly capable of use in the recited textile applications.

With respect to the latter exception, it is reasonable to presume that said ratio is inherent to the Luo invention. Support for said presumption is found in the use of similar materials (i.e. lyocell fibers having a denier of about 3-20). Like materials cannot have mutually exclusive properties. The burden is upon applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed ratio V would obviously have been provided by the process disclosed by Luo. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1-4, 6-8, and 10 stand rejected as being anticipated by or obvious over the cited prior art.

11. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,235,392 issued to Luo et al.

The features of Luo have been set forth above.

Claim 11 is drawn to a lyocell fiber having a titre of 6-25 dtex and the recited V ratio. Said fiber is made by a specified process. In other words, claim 11 is a product-by-process claim. With respect to the limitations describing the process of making the fiber, it is noted that said limitations are not given patentable weight at this time. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the

product in the product-by-process claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964.

It is the Examiner's position that the lyocell fiber of the Luo reference is identical or only slightly different than the presently claimed lyocell fiber prepared by the method presently claimed, because both comprise the same composition and same fiber titer. The burden is shifted to applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289.

Note with respect to the recitation that the fiber is antistatic, while Luo fails to explicitly teach this property. However, it is asserted the lyocell fiber of Luo will inherently meet this property. Like materials cannot have mutually exclusive properties. Therefore, claim 11 is rejected as being anticipated by or obvious the cited prior art.

#### ***Claim Rejections - 35 USC § 103***

12. In the alternative, claims 1-4, 6-8, and 10 are rejected under 35 U.S.C. 103(a) as obvious over US 6,235,392 issued to Luo et al.

In the event, the preamble limitation to the use of the fiber in the recited applications is given patentable weight (or in the event applicant amends the claims to include active method steps of using the fibers in said applications), the claims are alternately rejected as being obvious over the Luo reference.

While Luo fails to teach the use of said fibers in the specifically recited applications, the reference does teach teaches the lyocell fibers are used to make yarns, woven fabrics, and/or

nonwoven fabrics (abstract and col. 1, lines 9-12). Said applications are known to make use of regenerated cellulose fibers. Applicant is hereby given Official Notice of this fact. As such, it would have been readily obvious to one skilled in the art to employ the lyocell fibers of Luo in said applications. [The examiner notes that the facts asserted to be common and well-known are capable of instant and unquestionable demonstration as being well-known. To adequately traverse such a finding, applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.] Therefore, claims 1-4, 6-8, and 10 are rejected as being obvious over the cited prior art.

***Response to Arguments***

13. Applicant's arguments filed with the amendment of 05/06/2009 have been fully considered but they are not persuasive.
14. Applicant argues the claims are novel since the Luo reference does not teach lyocell fibers in the fields of applications recited in claim 1 (Amendment, page 6, 4th paragraph). This argument is found unpersuasive for the reasons set forth above. To reiterate, the cited applications are not given patentable weight at this time and the anticipation rejection is maintained. In the event, said applications are given patentable weight, the claims are deemed obvious over the Luo reference.
15. Regarding applicant's argument that Figure 1 of the specification show surprising results obtained from the invention (Amendment, page 6, 6<sup>th</sup> paragraph), it is noted that said arguments are not commensurate in scope with the claimed subject matter. Specifically, applicant argues

the surprising results are obtained (i.e., a V ratio of 2.2 or less) is obtained with a fiber having a titer of 6 dtex or more (Amendment, page 6, 6<sup>th</sup> paragraph). However, Figure 1 shows the desired V ratio results are obtained from fibers having a titer of 13 or more. In fact, the figure and Table 1 of the specification fail to provide results fiber samples of titers of 6-12 dtex. Hence, applicant's argument is not commensurate in scope with the claims. Additionally, applicant has not shown why said results are indeed unexpected or surprising.

### *Conclusion*

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached at 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Cheryl Juska/  
Primary Examiner  
Art Unit 1794*

cj  
August 19, 2009